

7

REMARKS

Applicant has carefully reviewed the Office Action dated September 8, 2004. Claims 1-22 are pending in this application. Applicant has amended Claims 1, 12, 13 and 16 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

Claims 1-22 have been objected to for failing to provide proper antecedent basis for the claimed subject matter. The Examiner has specifically pointed out the terms "means for transferring said extracted encoded information from said MRC"

Claims 1-22 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite because for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims have been amended to further clarify this aspect.

The Examiner has specifically pointed out that Applicant has not clearly linked and associated any corresponding structure with the claimed "means for transferring said extracted encoded information from said MRC" This language requires that the function associated with the means plus function language of this section claim is to transfer from the extraction device two items, the extracted encoded information and the unique identification information to a retail processing system. This is described with respect to Figs. 25, 26 and the flow charts of Figs. 27 and 28. The MRC code is extracted by the scanner 2500 which is operable to scan the MRC of an article of commerce. The operation of extracting the information is disclosed with respect to the block 2706 of flow chart 27. Block 2714 indicates the transmission of this information to the point of sale terminal, i.e., the retail processing system. The functionality requires a wireless link between a portable scanner that stores the information and the operation of this is described beginning on page 45, line 12 with the description of Fig. 25. It is set forth on page 46, line 5 that, when the user has completed the selection process, the user then "transmits" the MRC data 2504 of the purchased article by "pressing" a transmit button. This

AMENDMENT AND RESPONSE
S/N 09/597,131
Atty. Dkt. No. PHL Y-25,357

data is then transmitted over a wireless link to the receiver 2508 connected to the PC. Therefore, the function is to transmit the information extracted by the extraction device to a receiver and this is facilitated through the use of a wireless transmitter that has associated therewith a scanner. Further, the unique ID is the ID that is associated with the transmitted data and that is what is transmitted to the receiver. Thus, Applicant believes that this functionality is a functionality that is being requested by the Examiner.

Claims 1 and 12 were noted by the Examiner as being somewhat unclear with respect to the term "with the extraction operation of said extraction circuit" and what it modifies. This language has been altered in Claim 12 with an amendment and this is believed to provide sufficient clarification to the claim. However, this language does not appear in Claim 1 and, as such, no amendment to Claim 1 was made in response thereto.

In view of the above, Applicant respectfully requests the withdrawal of the 35 U.S.C. §112 rejection with respect to Claims 1-22.

Claims 12-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Ogasawara*. This rejection is respectfully traversed with respect to the amended claims.

Applicant has described the operation of *Ogasawara* in prior responses. However, the Examiner has indicated that all of the elements are illustrated in *Ogasawara*. The Examiner specifically stated that the "ownership of the article is transferred after receiving encoded information (and payment), but the Examiner did not specifically point to any specific language in *Ogasawara* for the payment provision in response to the information transferred "from the extraction device" to the POS. Applicant believes that this is a key aspect that is missing from *Ogasawara*. *Ogasawara* is nothing more than a portable scanner that is utilized to keep a history of lists and location information for the purpose of providing information to a user. However, the *Ogasawara* reference is a reference that provides a local terminal for the purpose of allowing a customer to scan a bar code, transmit this information to a store's central computer and then

AMENDMENT AND RESPONSE
S/N 09/597,131
Atty. Dkt. No. PHL-25,357

retrieve information about that item's location. Further, a customer's shopping list can be input to the system and then the system organized to choose the closest item such that the shopping experience of the user is more comfortable and more efficient. This shopping list can be stored on a customer's ID card (which was previously stored thereon at a customer's home computer) and then input to the mobile terminal, which is then transmitted to the store's central computer over the wireless link. Further, the shopping list could be uploaded to the Internet to the store's web site to an interconnection and then downloaded from the web site to the local terminal. Further, the optical scanner can read the handwritten shopping list. Thus, this mobile terminal is utilized to provide information to the user and not to facilitate the completion of a transaction. Claim 1 and Claim 12 both require that encoded information from MRCs be extracted and stored in a temporary buffer in conjunction with a mobile ID number. When this MRC and the unique identification information are downloaded to the retail processing system "from the extraction device," the commercial transaction is completed and ownership of the article of commerce is transferred to the user to complete the transaction. The *Ogasawara* reference does provide for the scanning of an MRC and Applicant would not argue that there must be some type of temporary storage of the MRC before transfer therefrom. From the standpoint of unique information, the description in Col. 10, beginning at line 25 in the associated paragraph indicates that a unique customer ID can be stored on the terminal, it being noted that this is different than a unique terminal ID. This is unique information that uniquely identifies the user to the central core system. However, there is no disclosure in *Ogasawara* that suggests or discloses that, in response to the step of extracting the MRC information, the step of transferring the MRC information "from the extraction device" to the retail processing system and the step of receiving the transferred MRC information at the receiving system "from the extraction device" in association with the transfer of unique identification information will in any way result in transfer of ownership of the article of commerce to the user to complete the transaction. Although there is some indication that purchase history is maintained, there is no disclosure as to how this person's history is updated in the database. For example, at Col. 8, beginning at line 55, *Ogasawara* indicates that, when a customer "desires to purchase an item," that the customer would scan an item's UPC bar code into the system. All that happens, however, is that the

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL-25,357

store's central computer will provide the price information or location information to that user as a result of such transfer. There is no disclosure that sets forth that this information will be transmitted to the core server and put into a shopping cart for that individual such that ownership is transferred to the user. If such were disclosed, there would have to be some disclosure of payment method. Such disclosure does not exist within *Ogasawara*. As such, Applicant believes that *Ogasawara*, due to the fact that there is no disclosure as to actually effecting completion of a commercial transaction with the bar code and terminal ID information transferred from the portable terminal, fails to anticipate Claims 12-22 or Claims 1-11. As such, Applicant respectfully requests the withdrawal of the 35 U.S.C. §102(e) rejection with respect to Claims 1-22. This is with respect to *Ogasawara*.

Claims 12-22 and Claims 1-11 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ogasawara*. As noted herein above, *Ogasawara* discloses no way to complete a commercial transaction and transfer ownership of a product to a user. There must be some type of payment in order for such to happen. Further, even if one were to assume that the system could make such a transaction, it would not be in response to the transfer of the MRC from the portable terminal. In order for a commercial transaction to be complete, the user would typically have to provide some credit card information or some access to a credit card location to automatically debit that location. Applicant does not see any such indication or suggestion in *Ogasawara* for such to happen. Rather, all that *Ogasawara* does is to record a history of purchases as opposed to completing that purchase by debiting the user's credit card account or bank account. Certainly, for a purchase to occur, that must happen at a later time but it is not in response to transfer of the MRC to the retail processing system. Thus, Applicant believes that, without some suggestion or motivation, one of ordinary skill in the art would not have modified *Ogasawara* to perform the claimed function of completing the transaction. Therefore, Applicant respectfully requests the withdrawal of the 35 U.S.C. §103(a) rejection with respect to Claims 1-11 and 12-22 in view of *Ogasawara*.

AMENDMENT AND RESPONSE
S/N 09/597,131
Atty. Dkt. No. PHLY-25,357

11

Claims 1-5 and 12-16 have been alternatively rejected under 35 U.S.C. §102(e) as being clearly anticipated by *Barnett*. This rejection is respectfully traversed. As set forth herein before, Applicant is of the position that *Barnett* does not disclose the concept of obtaining the information in an MRC with an extraction device and transferring "from the extraction device" to a receiving system at a retail processing system this MRC information in conjunction with unique identification information. This transferred information "from the extraction device" is then utilized by the retail processing system to complete a transaction. Applicant notes that certainly an MRC is utilized to transfer information to a POS and that would be used to complete a transaction, but there is no disclosure in *Barnett* that such would occur with an extraction device that would have unique user information contained therein and which was transferred from the extraction device to the POS. Applicant does admit that a scanner would scan a code and transfer that code to a POS system which would then complete the transaction. However, this scanner does not associate that scanning operation with unique information to identify the user which is transferred with the MRC to the retail processing system. As such, Applicant respectfully requests the withdrawal of the 35 U.S.C. §102(e) rejection with respect to Claims 1-5 and 12-16 in view of *Barnett*.

With respect to paragraph 15, the Examiner has again confirmed that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to meanings other than the ordinary and accustomed meanings. The Examiner refers to the fact that this is due to the fact that Applicant has not pointed to any term or terms in the claims from which to draw in any limiting statements. Applicant has discussed this with the Examiner in detail.

In his response to the Examiner's comments in this conversation, the Examiner and Applicant discussed the provisions of MPEP 2111 which requires the claims to be interpreted with their broadest reasonable interpretation. The Patent Office rules require that the pending claims must be "given their broadest reasonable interpretation consistent with the specification." However, this section further requires that the claims must also be consistent with the interpretation that those skilled in the art would reach. In section MPEP 2111.01, the Patent

AMENDMENT AND RESPONSE
S/N 09/597,131
Atty. Dkt. No. PHL Y-25,357

Office sets forth that claims must be given their "plain meaning" unless they are defined in the specification differently. In this section, it is set forth that "the specification must be reviewed to determine 'whether the presumption of ordinary and customary meaning is rebutted.'", citing *Texas Digital*, 308 F.3d at 1204. As such, Applicant agrees that if the specification were to set forth an explicit definition for a term such that that explicit definition will control interpretation of the term as it is used in the claim, this definition would rule. Further, the Patent Office sets forth in MPEP 2111.01(III) that any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention," citing *Multiform Desiccants, Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477.

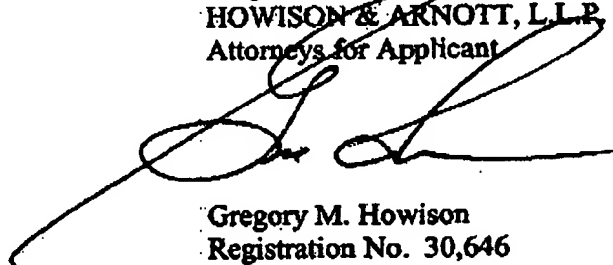
In view of the above, Applicant believes that the Examiner is correct in using the ordinary meaning or the plain meaning of a term, read in light of the specification for the purpose of prosecuting the case. However, Applicant also takes the position that reading the claim with the broadest possible interpretation will not prevent a later finding that the term may be more narrowly defined by a close evaluation of the specification in a subsequent litigation, should such claim be the subject matter of such litigation. For the purpose of prosecution and only for that purpose, Applicant believes that the Examiner is correct in accordance with the guidelines of the Patent Office to view the claim with the plain meaning provisions set forth in MPEP 2111. Hopefully, the position between the Examiner and Applicant may be clearer, although they may still disagree. Hopefully, the other aspects with respect to the rejections in view of the art will go forward.

AMENDMENT AND RESPONSE
S/N 09/597,131
Atty. Dkt. No. PHL-25,357

13

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-25,357 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,
HOWISON & ARNOTT, L.L.P.
Attorneys for Applicant



Gregory M. Howison
Registration No. 30,646

GMH/yoc/keb

P.O. Box 741715
Dallas, Texas 75374-1715
Tel: 972-479-0462
Fax: 972-479-0464
January 7, 2005

AMENDMENT AND RESPONSE
S/N 09/597,131
Atty. Dkt. No. PHLY-25,357